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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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04/28/2005

Michael Herzog

HERZ3001/FJD

5257

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BACON & THOMAS, PLLC

625 SLATERS LANE

FOURTH FLOOR

ALEXANDRIA, VA 22314-1176

EXAMINER

KOO, GARY J

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,149	<b>Applicant(s)</b> HERZOG, MICHAEL	
	<b>Examiner</b> GARY KOO	<b>Art Unit</b> 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/25/2005; 07/12/2004</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. This action is in response to the application filed 07/12/2004.
2. Claims 19-36 are pending.
3. Claims 19-36 are rejected.

### ***Priority***

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on 04/28/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
6. The information disclosure statement (IDS) submitted on 07/12/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claims 32-36 include in the limitations a device type manager (DTM). The specification does not disclose what a device type manager is.

Claims 34 and 35 include in the limitations control files. The specification does not disclose what a control file is.

### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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9. Claims 32-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for device type managers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention commensurate in scope with these claims. The specification does not disclose what a device type manager is.

10. Claims 34 and 35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, does not reasonably provide enablement for control files. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention commensurate in scope with these claims. The specification does not disclose what a control file is.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 32-36 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 32-36 include in the limitations a device type manager (DTM). The specification does not disclose what a device type manager is. For purposes of examination, the examiner has interpreted a device type manager as “information”.

Claims 34 and 35 include in the limitations control files. The specification does not disclose what a control file is. For purposes of examination, the examiner has interpreted a control file as “information”.

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 19-36 are rejected under 35 U.S.C. 102(e) as being anticipated by DeWolfe et al. (US 20020032626 A1).

*As per claim 19, DeWolfe teaches:*

- **19. A method for maintaining a production installation having a plurality of field devices (F1, F2, F3), which are partly, or completely, connected over a data bus D with a control system L, comprising the steps of:** (DeWolfe, [0009], "The present invention relates to networked computer systems and methods for asset registration and for conducting business (e.g. across a network) regarding the assets.")
- **electronically registering the field devices (F1, F2, F3) in a manufacturer database (HG-DB) with a manufacturer-specific identification and manufacturer-specific information relevant for the maintaining; electronically registering the field devices in a customer database (IB-DB) with a customer-specific identification and customer-specific information;** (DeWolfe, [0012], "Ownership and other attributes of "objects," including digital objects may be captured in a single, inter-operable database or in multiple and distinct databases or both. A GAIR contains, among other data, data regarding the object, producer, the owner and other agencies or individuals with a stockholder's interest in the same.")
- **and electronically querying the two databases (HG-DB and IB-HG) on the basis of maintenance criteria.** (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

*As per claim 20, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

- **20. The method as claimed in claim 19, wherein: the manufacturer-specific identification is the serial number of the field device (F1, F2, F3).** (DeWolfe, [0045], "Typically

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assets are defined by a set of device dependent common characteristics, which include but are not limited to: ... serial number")

*As per claim 21, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

**21. The method as claimed in claim 19, wherein: the customer-specific identification is the tag number of the field device (F1, F2, F3).** (DeWolfe, [0045], "Typically assets are defined by a set of device dependent common characteristics, which include but are not limited to: ... registration number")

*As per claim 22, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

**- 22. The method as claimed in claim 19, wherein: the maintenance criteria include corrective maintenance, replacement or preventive maintenance.** (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

*As per claim 23, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

**- 23. The method as claimed in claim 19, wherein: the database querying yields a maintenance plan.** (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

*As per claim 24, the rejection of claim 23 is incorporated and further DeWolfe teaches:*

**- 24. The method as claimed in claim 23, wherein: the maintenance plan is stored in a maintenance database and every separate point of the maintenance plan is confirmed or modified by the customer before the storing.** (DeWolfe, [0049], "Transactions 210

may be associated with documents 220 and vice versa. Documents 220 may include but are not limited to ... maintenance records")

*As per claim 25, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

- 25. The method as claimed in claim 19, wherein: the manufacturer database (HG-DB) also includes foreign devices of other manufacturers.** (DeWolfe, [0040], "In a preferred embodiment, any individual or organization who entered data pertaining to an asset would always have access to that data. For example, a parts provider would always have access to their data (i.e., the assets the parts were in). For example, a tire manufacturer would have access to the GAIR 100 to identify all vehicles that their tires were installed on")

*As per claim 26, the rejection of claim 25 is incorporated and further DeWolfe teaches:*

- 26. The method as claimed in claim 25, wherein: the manufacturer database (HG-DB), or portions thereof, come from Internet databases.** (DeWolfe, [0008], "The database would be broadly available across computer networks, such as the Internet")

*As per claim 27, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

- 27. The method as claimed in claim 19, wherein : the time required for the maintenance of the field devices (F1, F2, F3) is stored in said manufacturer database (HG-DB) and from this information, combined with the maintenance plan, projected costs of maintenance work are calculated.** (DeWolfe, [0113], "Other manufacturers could use the GAIR to more accurately forecast failures and other expected costs (such as would be involved in recalls, warranty "actuarial" analyses, parts and service evaluations, etc.).")

*As per claim 28, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

- 28. The method as claimed in claim 19, wherein: already-experienced, actual expenses of the maintenance work for the field devices (F1, F2, F3) are stored in said customer database (IB-DB) and a projected versus actual cost comparison is produced for the maintenance plan.** (DeWolfe, [0113], "Other manufacturers could use the GAIR to more

accurately forecast failures and other expected costs (such as would be involved in recalls, warranty "actuarial" analyses, parts and service evaluations, etc.).")

*As per claim 29, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

- *29. The method as claimed in claim 19, wherein: the manufacturer database (HG-DB) contains replacement part information and the database querying determines the optimal replacement part and consumable materials inventory for the chosen maintenance strategy.* (DeWolfe, [0107], "These records would be used subsequently for purposes such as ... repair and replacement part identification and procurement")

*As per claim 30, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

- *30. The method as claimed in claim 19, wherein: the customer database (IB-DB) is supplemented and modified by the operator itself of the production installation, via Internet access.* (DeWolfe, [0015], "In one embodiment, the asset registry would be broadly accessible across an electronic network. This would be accomplished, in part, through the use of generic or common software tools such as WWW browsers, Web Servers and Internet Transfer Protocols or other like computers and networks.")

*As per claim 31, the rejection of claim 30 is incorporated and further DeWolfe teaches:*

- *31. The method as claimed in claim 30, wherein: the operator receives automatically and via Internet a maintenance plan adapted to a changed inventory of field devices (F1, F2, F3) or changed requirements for the maintenance strategy.* (DeWolfe, [0015], "In one embodiment, the asset registry would be broadly accessible across an electronic network. This would be accomplished, in part, through the use of generic or common software tools such as WWW browsers, Web Servers and Internet Transfer Protocols or other like computers and networks.")

*As per claim 32, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

- *32. The method as claimed in claim 19, wherein: device type managers (DTMs) are stored in said manufacturer database (HG-DB) and are included in the maintenance*



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***plan in execution specifications intended for the maintenance personnel.*** (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

***As per claim 33, the rejection of claim 32 is incorporated and further DeWolfe teaches:***

***- 33. The method as claimed in claim 32, wherein: electronic aids used for the maintenance are automatically adjusted by the maintenance plan.*** (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

***As per claim 34, the rejection of claim 19 is incorporated and further DeWolfe teaches:***

***- 34. The method as claimed in claim 19, wherein: the maintenance plan represents the control file for asset management systems.*** (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

***As per claim 35, the rejection of claim 34 is incorporated and further DeWolfe teaches:***

***- 35. The method as claimed in claim 34, wherein: control files for various asset management systems are produced by controlling the device type managers (DTMs).*** (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

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*As per claim 36, the rejection of claim 19 is incorporated and further DeWolfe teaches:*

*- 36. The method as claimed in claim 19, wherein: a plurality of manufacturers support manufacturer databases (HG-DB) in the Internet and, for each device in an installation, the appropriate link to the corresponding Internet address of the manufacturer database (HG-DB) is contained in the device type manager (DTM - e.g. FDT Tool) of the particular device. (DeWolfe, [0008], "The database would be broadly available across computer networks, such as the Internet")*

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are included in the attached form PTO-892.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY KOO whose telephone number is (571)270-3887. The examiner can normally be reached on Monday to Friday 9:30am to 6:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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